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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Indian Nation Leather company

Serial No. 74/294,182

Mark G. Kachigian of Head & Johnson, P.A. for Indian Nation
Leather Company

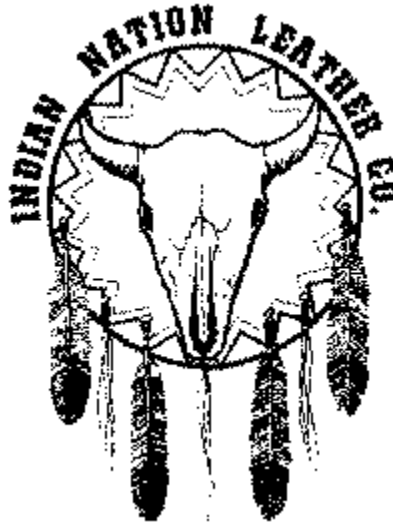
Ari Leifman, Trademark Examining Attorney, Law Office 102
(Myra K. Kurzbard, Managing Attorney)

Before Simms, Hanak and Hohein, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Indian Nation Leather Company (applicant) seeks to register INDIAN NATION LEATHER CO. and design in the form shown below for "wholesale distributorship and mail-order services for equestrian equipment, namely: saddles, bridles, bits, brushes, billets, bell boots, cinches, curry combs, flank sets, halter, rasp, spurs, whips, latigos, leads, shipping boots, punches, splint boots, pads, blankets and

veterinarian supplies." The application was filed on July 14, 1992 with a claimed first use date of December 1986. In response to the first office action, applicant disclaimed the exclusive right to use LEATHER CO. apart from the mark as shown. In response to the fifth office action, applicant expanded its disclaimer to disclaim the exclusive right to use INDIAN NATION LEATHER CO. apart from the mark as shown.



After a lengthy examination process spanning four years and involving various grounds of refusal, the Examining Attorney finally refused registration on two grounds. First, the Examining Attorney refused registration pursuant to Section 2(a) of the Lanham Trademark Act because of the Examining Attorney's belief that the mark consists of "matter which falsely suggests a connection with persons, namely, Native American persons." (Examining Attorney's brief page 1). Second, the Examining Attorney refused

registration "on the further ground that the use of the mark in connection with the services violated the Federal Indian Arts and Crafts Act, 18 U.S.C Section 1159(a), and that in view of this, the applicant could not assert lawful use of the mark in commerce under Trademark Act Sections 1 and 45." (Examining Attorney's brief page 1).

In order to be properly refused registration pursuant to Section 2(a), the mark in question "must point uniquely to" persons, living or dead, institutions, beliefs, or national symbols. The University of Notre Dame v. J. C. Food Imports, 703 F. 2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983).

The Examining Attorney has simply failed to demonstrate that the applied for mark violates Section 2(a) for at least two reasons. First, the Examining Attorney has not established that the term "Indian Nation" is recognized as referring uniquely to specific persons, and in particular, to use the Examining Attorney's own words, "Native American persons." The Examining Attorney argues that "the literal portion of the mark includes INDIAN -- a term frequently used to denote Native Americans." (Examining Attorney's brief page 4). However, while there is evidence to indicate that some tribes of American Indians are referred to by their tribal name followed by the term "Indian Nation" (i.e. Yakima Indian Nation), there is no evidence to indicate that American Indians in general are referred to as to the Indian Nation.

Second, applicant has made of record substantial evidence showing that the State of Oklahoma is still occasionally referred to as the Indian Nation, and that more commonly, that the central and eastern regions of Oklahoma are known as the Indian Nation. Applicant has made of record a list of dozens of companies operating in Oklahoma whose names begin with the term INDIAN NATION. These include Indian Nation Power, Indian Nation Fuel, Indian Nation Gas Supply, Indian Nation Aviation, Indian Nation Energy and many others. In addition, applicant has made of record evidence demonstrating that there is an Indian Nation Council of Governments which has no connection with Native Americans, but instead is a planning committee for the City of Tulsa and surrounding communities. Finally, applicant has demonstrated that there is a turnpike in eastern Oklahoma called the Indian Nation Turnpike, and that this turnpike derives its name from the geographic region where it is located, much like the Ohio Turnpike or the Pennsylvania Turnpike.

The Examining Attorney has even conceded that "a plausible reading of [applicant's] evidence" demonstrates "that INDIAN NATION designates a geographic region." (Examining Attorney's brief page 9).

Thus, even if we were to assume for the sake of argument that the Examining Attorney established that the term INDIAN NATION referred to all Native Americans (which he did not), the Examining Attorney still did not establish

that the term INDIAN NATION "points uniquely" to Native Americans. The Examining Attorney has conceded that INDIAN NATION designates a geographic region. Indeed, it is in this very geographic region where applicant's Langley, Oklahoma headquarters are located.

We will consider next the Examining Attorney's contention that applicant's use of its mark is unlawful because it purportedly violates the aforementioned Indian Arts and Crafts Act. According to the Examining Attorney, that Act reads, in part, as follows: "It is unlawful to offer or display or sell any good, with or without a government trademark, in a manner that falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian tribe or Indian arts and crafts organization, resident within the United States." (Examining Attorney's brief page 16).

This Board has held that "in trying to determine whether use of a mark is lawful under one or more of the myriad regulatory acts, [the better practice] is to hold a use in commerce unlawful only when the issue of compliance has previously been determined (with a finding of non-compliance) by a court or government agency having competent jurisdiction under the statute involved, or where there has been a per se violation of a statute regarding the sale of a party's goods." Kellogg Co. v. New Generation Foods, 6 USPQ2d 2045, 2047 (TTAB 1988). See also 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 19:124

at page 19-216 (4th ed. 1996). It should be noted that the holding of New Generation Foods is specifically referenced in Section 907 of the Trademark Manual of Examining Procedure (2d ed. 1993).

The Examining Attorney has never contended that applicant's use for over ten years of its mark has ever been determined "by a court or government agency having competent jurisdiction" to be unlawful.

As for applicant's use constituting a possible "per se violation of a statute," we note that this ground of refusal was very belatedly raised for the first time in Office Action No. 5 of November 28, 1994 when the Examining Attorney stated that the "use of [applicant's] mark would appear not to meet the requirements of the Indian Arts and Crafts Act," and "that registration of the applicant's mark may be barred by the Indian Arts and Crafts Act." (Office Action No. 5 page 2, emphasis added). We find that use of applicant's mark by no means constitutes a per se violation of any statute, if indeed, it constitutes any violation of any statute. Indeed, given the geographic significance of the phrase INDIAN NATION, and the fact that applicant is located within that geographic region, it would appear that the word portion of applicant's mark (which has been disclaimed in its entirety) aptly describes applicant, namely, a LEATHER CO. located in the INDIAN NATION (i.e. central to eastern Oklahoma).

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Decision: The refusal to register on both grounds is reversed.

R. L. Simms

E. W. Hanak

G. D. Hohein
Trademark Administrative
Judges, Trademark Trial
and Appeal Board